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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,458	02/17/2004	Jennifer Slabe	AVERP3513USA	1390

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EXAMINER

NORDMEYER, PATRICIA L

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/780,458

Applicant(s)

SLABE ET AL.

Examiner

Patricia L. Nordmeyer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 21-37 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
- Paper No(s)/Mail Date 5/04.

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1 - 20, drawn to an adhesive article, classified in class 428, subclass 40.1.
 - II. Claims 21 - 37, drawn to a method of preparing an adhesive article, classified in class 156, subclass 60.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions Group II, claims 21 - 37 and Group I, claims 1 - 20 are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process such as extruding a layer of pressure sensitive adhesive on the light weight paper before placing a release liner on the adhesive and cutting the formed material into a desired shape and size.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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4. During a telephone conversation with Heidi Boehlefeld on October 20, 2005 a provisional election was made with traverse to prosecute the invention of Group I, claim1 - 20. Affirmation of this election must be made by applicant in replying to this Office action. Claim21 – 37 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 4 – 6 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Porter et al. (USPN 5,881,521).

Porter et al. disclose an adhesive article comprising a pressure sensitive adhesive layer made from an acrylic (Column 5, lines 36 – 43) having a first surface and second surface (Figure 2, #35) and a lightweight paper (Column 3, lines 43 – 46) made from a major amount of non-wood fibers (Column 3, lines 27 – 35) adhered to the first surface with a release liner releasably adhered to the second surface of the adhesive layer (Column 5, lines 53 – 55; Figure 2, #30) as in claims 1, 4 – 6 and 9.

8. Claims 1, 4, 9, 17 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Laszutko et al. (USPN 5,653,473).

Laszutko et al. discloses a adhesive article (Column 1, lines 9 – 10) comprising a pressure sensitive adhesive layer having a first surface and second surface (Figure 2, #40) and a lightweight paper made with a major amount of non-wood fibers (Column 4, lines 52 – 59; Figure 2, #34) adhered to the surface as in claims 1 and 4. With regard to claim 9, a release liner is releasably adhered to the second surface of the pressure sensitive adhesive layer (Figure 2, #36). As in claim 17, the adhesive article (Column 1, lines 9 – 10) comprises a light weight paper layer having a upper and lower surface(Figure 3, #36; Column 4, lines 52 – 60), a first adhesive layer having an upper and a lower surface (Column 4, lines 34 – 47) wherein the upper surface of the adhesive layer is adhered to the lower surface of the light weight paper layer (Figure 3, #42), a polymeric film having an upper surface and a lower surface wherein the upper surface of the polymeric film is adhered to the lower surface of the adhesive layer (Figure 3, #26; Column 4, line 66 to Column 5, line 4) and a second adhesive layer having an upper surface and

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a lower surface wherein the second adhesive comprises a pressure sensitive adhesive (Column 3, lines 22 – 24) and the upper surface of the second adhesive layer is adhered to the lower surface of polymeric film (Figure 3, #30). A release liner is releasably adhered to the lower surface of the second adhesive layer (Figure 3, #28) as in claim 20.

9. Claims 1 – 6, 9, 11, 12 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Keiser (USPG Pub 2002/0176973).

Keiser discloses an adhesive article comprising a pressure sensitive adhesive layer made from an acrylic (Page 5, Paragraph 0057) having a first surface and second surface (Figure 4, #34) and a lightweight paper made from a major amount of non-wood fibers having a weight of less than 100 grams per square meter (Page 2, Paragraph 0024) adhered to the first surface (Figure 4, #36) with a release liner releasably adhered to the second surface of the adhesive layer (Figure 4, #32) as in claims 1, 4 – 6, 9, 11, 12 and 15. The paper has a weight of less than 150 grams per square meter and less than 125 grams per square meter (Page 2, Paragraph 0024) as in claims 2 and 3.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 7, 8, 10, 13, 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keiser in view of Krish et al. (USPN 6,187,432).

Keiser discloses an adhesive article comprising a pressure sensitive adhesive layer made from an acrylic (Page 5, Paragraph 0057) having a first surface and second surface (Figure 4, #34) and a lightweight paper made from a major amount of non-wood fibers having a weight of less than 100 grams per square meter (Page 2, Paragraph 0024) adhered to the first surface (Figure 4, #36) with a release liner releasably adhered to the second surface of the adhesive layer (Figure 4, #32). However Keiser fail to disclose the pressure sensitive adhesive layer having a coat weight up to about 50 gsm, from about 5 to 35 gsm and a release value of from about 30 to 90 gsm.

Krish et al. teach a coating weight for pressure sensitive adhesive material chosen from rubber based adhesive, acrylic adhesives, vinyl ether adhesive, silicone adhesives or combinations thereof (Column 26, lines 57 – 60) between 2 and 100 gsm (Column 11, lines 14 – 19) in an adhesive article (Column 1, lines 15 – 17) made with light weight paper (Column 10, lines 26 – 51) with a peel force between 0.2 and 1.3 lb/in (Column 25, Table 1) for the purpose of tailoring the surface and bulk characteristics of the adhesive to achieve a wide range of desired performance characteristics (Column 26, lines 3 – 6).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the coating of the adhesive material in Keiser in order to

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tailor the surface and bulk characteristics of the adhesive to achieve a wide range of desired performance characteristics as taught by Krish et al.

12. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laszutko et al. in view of Keiser.

Laszutko et al. the adhesive article (Column 1, lines 9 – 10) comprises a light weight paper layer having a upper and lower surface(Figure 3, #36; Column 4, lines 52 – 60), a first adhesive layer having an upper and a lower surface (Column 4, lines 34 – 47) wherein the upper surface of the adhesive layer is adhered to the lower surface of the light weight paper layer (Figure 3, #42), a polymeric film having an upper surface and a lower surface wherein the upper surface of the polymeric film is adhered to the lower surface of the adhesive layer (Figure 3, #26; Column 4, line 66 to Column 5, line 4) and a second adhesive layer having an upper surface and a lower surface wherein the second adhesive comprises a pressure sensitive adhesive (Column 3, lines 22 – 24) and the upper surface of the second adhesive layer is adhered to the lower surface of polymeric film (Figure 3, #30). However Laszutko et al. fail to disclose the paper having a weight of less than 150 grams per square meter and less than 125 grams per square meter.

Keiser teach a lightweight paper made from a major amount of non-wood fibers (Page 2, Paragraph 0024) having a weight of less than 150 grams per square meter and less than 125 grams per square meter (Page 2, Paragraph 0024) for the purpose of forming a laminate made

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from cellulosic material that is substantially dimensionally stable upon changes in ambient temperature (Page 1, Paragraph 0009).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the weight of the paper in Laszutko et al. since the papers discussed in both reference are made from non-wood fibers and in order to form a laminate made from cellulosic material that is substantially dimensionally stable upon changes in ambient temperature as taught by Keiser.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 6,110,554 to Moeller et al. is cited to show the state of the art with regard to adhesive articles formed from lightweight paper and pressure sensitive adhesive that is covered by a release liner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (571) 272-1496. The examiner can normally be reached on Mon.-Thurs. from 7:00-4:30 & alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patricia L. Nordmeyer
Examiner
Art Unit 1772

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Harold Pyon
HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

10/31/05